

**REMARKS**

Kindly replace the Amendment timely filed on the 16<sup>th</sup> of October 2009 with this Substitute Amendment in order to avoid questions of antecedent basis of amended claim 10, and in order to avoid questions of the claim identifier of amended claim 8.

The Office action mailed on 16 April 2009 (Paper No. 20090331) has been carefully considered. Allowance of claims 6 through 8 is noted with appreciation.

**Amendments to the Claims**

Claims 8, 9 and 10 are amended, and dependent claims 11 and 12 are newly added.

**Status of Claims**

Claims 1 through 5 have been previously canceled. Thus, claims 6 through 12 are pending in the application, of which claims 6 through 8 are allowed.

**Double Patenting**

Claims 9 and 10 are provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 90 and 120 of co-pending Serial No. 08/720,070. The Examiner states that:

“It is understood that these claims have been filed for the purposes of interference and are copied claims, however, claims 90 and 120, which correspond to the instant claims 9 and 10, are still pending in co-pending application 08/720,070, thus necessitating this rejection.”

**First**, and as was previously explained to the Examiner, Paper No. 20090331 is utterly devoid of any indication that the Examining staff has sought to comply with current U.S. practice; the Examiner must (A) determine the scope and content of a patent claim relative to a claim in the application at issue; (B) determine the differences between the scope and content of the patent claim as determined in (A) and the claim in the application at issue; (C) determine the level of ordinary skill in the pertinent art; and (D) evaluate any objective indicia of non-obviousness.<sup>1</sup> Here, the Examiner has made a summary conclusion that claims 9 and 10 are “claiming the same subject matter as that of claims 90 and 120 of copending Application No. 08/720,070.” There is no evidence of record to support the Examiner’s conclusion of double patenting over Applicant’s copending Application No. 08/720,070, where claims 90 and 120 were copied over a decade ago, and remain pending before this Examiner, without substantive, or competent action.

**Second**, this rejection continue to deviate from U.S. procedure as outlined in the *Manual*. As is clearly explained in the *Manual* “words in patent claims are given their ordinary meaning in the usage of the field of the invention, unless the text of the patent makes clear that the word was used with a special meanings.” *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1998). MPEP §804. Moreover, there is no evidence cited in Paper No. 20060322 which supports even the slightest inference that “the conflicting claims ... recite like elements using different

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<sup>1</sup> MPEP §804(B), Revision 3, August 2005.

terminology and/or phraseology” as is argued by the Examiner in support of this rejection. In point of fact, Paper No. 20061208 does not identify any “like elements” in any claim. In short, not only is there no evidence of record that these claims define “like elements”, this rejection simply seeks to may a summary conclusion of obviousness by equating the “structure and operable functional features” of different devices defined in the art. Unexplained in the Examiner’s conclusion is how an art recognized components might be employed to perform other functions of other art recognized components. Written clarification is respectfully requested in subsequent Office correspondence.

In view of the foregoing failure of the Examining staff to comply with the degree of completeness mandated by 37 C.F.R. §1.104(a)(b) and (c), Paper No. 20061208 is incomplete. Clarification in subsequent Office correspondence demonstrating substantive progress in the examination of Appellant’s 08/720.070 pending application which is required in order to sustain this rejection; the fact that the claims 90 and 120 remain pending for over a decade is not a lawful basis for an assertion of double patenting under 35 U.S.C. §101.

It should be noted therefore, that the Examiner has failed under 35 U.S.C. §§101 and 121 to satisfy any of the four requirements for double patenting analysis mandated by §804 of the *Manual of Patent Examining Procedure*, (8<sup>th</sup> Edition, Rev. 3) May 2007. This indicates a lack of both double patenting and of obviousness; consequently, there is no basis for asserting double patenting.

Moreover, this rejection is a “provisional rejection”, and may not be made final absent issued of at least one of Applicant’s co-pending Application No. 10/440,308 and co-pending

application Serial No. 08/720,070. The Board is not believed therefore, to have jurisdiction over this rejection. Withdrawal of this rejection is therefore respectfully requested. Such action is urged.

### **Rejection under 35 U.S.C. § 112**

Claims 9 and 10 are rejected under the first paragraph of 35 U.S.C. §112 for lack of enablement. Specifically, the Examiner states that the specification fails to provide support for the “at least one electromechanical locking member” and “plurality of electromechanical locking members” set forth in claims 9 and 10, respectively.

More specifically, the Examiner states that,

“[t]his rejection stands, since, firstly, the solenoid coils 109, are not disclosed ‘locking members’ as argued by applicant. Secondly, the specification discloses that the ‘plurality’ of locking members 106a, 107a, 108a are used alternatively and not as a plurality within the same plug. See the specification on page 12, lines 11 -14 which clearly recites the use of locking member 106a or 107a or 108a.”

This conclusion of law is nearly identical to the conclusion of law made by the Examining staff in Applicant’s Serial No. 08/720,070, where claims 90 and 120 were rejected under the first paragraph of 35 U.S.C. §112, with an averment that Appellant’s specification failed to satisfy the enablement requirement of the first paragraph of 35 U.S.C. §112 because these claims contain “subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and /or use the invention.” The rejection is improper for the following reasons.

Specifically, the Examiner states that the specification fails to provide support for the “at least one electromechanical locking member” and “plurality of electromechanical locking members” set forth in claims 90 and 120, respectively.

There, the Examiner argues that,

“firstly, the solenoid coils 109, argued on page 69 of the amendment filed 2/24/03, are **not** disclosed ‘locking members’.”

The Examiner has confused the disclosure in the specification. With reference to Figure 3, by way of example, the “solenoid coils” are identified by reference numbers such as “106d” or “106D”, or in Figure 5A, “108b”, and in Figure 5, as “108b”. The entire assembly however, is readily described as “a plurality of electromechanical locking members.” Moreover, Applicant clearly illustrate three discrete versions of these plurality of electromechanical locking members in Figure 1, and nowhere negates use of more than a single one of these plurality of electromechanical locking members.

The Examiner’s attention is invited to consider the question of enablement discussed in *Arnold C. Bilstad, the Gorge Wakalopulos*, 386 F.3 1116(CAFC 7 October 2004) where the Court noted “[T]hat a claim may be broader than the specific embodiment disclosed in a specification is in itself of no moment.” Here, as in Bilstad, Applicant discloses a plurality of single assemblies that, unlike references of record such as Gokcebay ‘777 contains “a plurality of electromechanical locking members” as well as “at least one electromechanical locking member” as set forth in claims 90 and 120, respectively.

The Examiner further argues that,

“The specification discloses that the ‘plurality’ of locking members 106a, 107a, 108a are used alternatively and not as a plurality within the same plug.” See the specification on page 12, lines 11 -13 which clearly recites the use of locking member 106a or 107a or 108a.”

Applicant notes that the discussion on page 12, lines 11-13 is one small portion of the entirety of Applicant’s specification, and that portion describes the interchangeability of these assemblies in different embodiments. Nothing in Applicant’s page 12 negates the use of a plurality of any one of these embodiments or the use of two, or more, different ones of these embodiments.

The Examiner is referred to *Lampi Corp. v. American Power Products, Inc.*, 228 F3d 1365, 1377-78 (Fed. Cir. 2000) which affirmed a District Court’s finding that disclosure of only identical half-shells were sufficient with description support for a claim in compassing both identical and non-identical half-shells. As a general rule, a disclosure of species provides sufficient written description support for a later filed claim directed to a genus.

Here, the Examiner seeks to ignore this general rule and instead, substitute a rule that disclosure of “one” invokes a “one and only one” limitation. This substitution was refuted by the U.S. Court of Appeals for the Federal Circuit, which held, in the interpretation of claims, “the use of the singular form “a” in conjunction with “comprising” and without narrowing language typically encompasses **both** singular and plural embodiments.”<sup>2</sup>

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<sup>2</sup> *Hyperphase Technologies, LLC v. Google, Inc.*, Case Nos 07-1125, -1176 (Fed.Cir. 26 December 2007) (Michel C. J.).

Consequently, the basis for this rejection is unattainable, and may not be sustained. The Examiner is respectfully urged therefore, to withdraw this rejection in view of the overwhelming adequacy of Applicant's disclosure of a multiplicity of embodiments which may be used either singularly, in various combinations of different species or in a plurality of like or different species. Such action is respectfully urged.

**A. Appellant's Originally Filed Specification Provides Enablement For The Subject Matter Defined By Claims 9 And 10**

In support of the rejection, Paper No. 20080619 states that,

“Claims 90 and 120 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains [*sic*] subject matter *which was not described in the specification* in such a way as to enable one skilled in the art ... to make and/or use the invention. Secondly, the specification discloses that the *plurality* of locking members 106a, 107a, 108a are used alternatively and not as a plurality within the same plug. See the specification on page 12, lines 11-13 which clearly recites the use of locking member 106a or 107a or 108a.”<sup>3</sup>

Under current Office practice,

“[t]o satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonable conclude that the inventor had possession of the claimed invention”.<sup>4</sup>

The typical issue “raised in the cases is most often phrased as whether the original

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<sup>3</sup> Paper No. 20080619, ¶3.

<sup>4</sup> *MPEP*, §2163, p. 2100-172 (Rev. 3, August 2005).

application provides ‘adequate support’ for the claims at issue or whether the material added to the specification incorporates ‘new matter’ in violation of 35 U.S.C. §132.”<sup>5</sup> Here, no matter has been added to the specification; the issue before the Examining staff is thus, “whether the original application provides ‘adequate support’ for” claims 90 through 120?

The Examining staff premised this rejection of claims 90 through 120 on grounds that,

“the instant specification fails to provide support for the *at least one electromechanical locking member* and *plurality of electromechanical locking members* set forth in claims 90 and 120, respectfully.”<sup>6</sup>

No other averment is made in support of this rejection. At issue therefore, is “whether the original application provides “adequate support” for the claims at issue”?

Appellant invites the attention of the Examining staff to Figures 2 through 7, and especially to the embodiment of Figure 3 which shows the distal portion 106a surrounding the distal portion 106B of detent 106A. In the language of the original specification, “[t]he open distal end of chamber 80 is intersected by a circumferential groove 101ℓ which may partially, or completely, encircle the exterior circumferential surface of plug 101”,<sup>7</sup> “[a]rmature 106a forms the radially outward distal end of solenoid coil 106b, and is radially outwardly biased by spring 106D so as to extend radially upwardly into the path of groove

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<sup>5</sup> MPEP, §2163, p. 2100-172 (Rev. 3, August 2005).

<sup>6</sup> Paper No. 20080619, ¶4, page 3.

<sup>7</sup> Original specification, page 12, lines 15 and 16.



101 $\ell$  and thereby engage detent 106A”,<sup>8</sup> and “cavity 106c will surround detent 106A.”<sup>9</sup> The attention of the Examining staff is further invited to page 14 of the originally filed specification, where Appellant teaches that,

“when an unidirectional electrical current is applied through the particular winding 106b, 107b, 108b, the corresponding shaft 106d, 107d, 108d will either axially reciprocate (*i.e.*, radially through its corresponding chamber 82) along axis A or incrementally rotate (*e.g.*, by ninety degrees within its corresponding chamber 82) around axis A and thereby alter the positional relation between blocking detent 106A or 107A relative to the corresponding blocking armature 106a, 107a or 108a”.<sup>10</sup>

Turning to page 25, Appellant further teaches that,

“The plug is configured with the electrical operator maintaining the distal member within the plug with the distal member extended not beyond the exterior surface while the distal member is in the first position, and maintaining the distal member in engagement with the cylinder while the distal member is in the second position”.<sup>11</sup>

In short, one distal end (of chamber 80)<sup>12</sup> does in fact **surround** another distal end (of armature 106a)<sup>13</sup>, and, depending upon the “orientation relative to said exterior surface obstructing said relative movement when said distal member at least partially surrounds said

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<sup>8</sup> Original specification, page 12, lines 18 through 20.

<sup>9</sup> Original specification, page 14, line 15.

<sup>10</sup> Original specification, page 14, lines 5-10.

<sup>11</sup> Original specification, page 25, lines 7-10.

<sup>12</sup> Original specification, page 12, line 15.

<sup>13</sup> Original specification, page 12, line 18.

distal member.”<sup>14</sup> Alternatively, and referring again to the foregoing excerpts from Appellant’s originally filed specification in conjunction with Figure 3, the distal end of armature 106a and its exposed recess 106c will surround the distal end of detent 106A and, depending upon the “orientation relative to said exterior surface obstructing said relative movement when said distal member at least partially surrounds said distal member.”<sup>15</sup> Although the language of claim 11 may be open to an alternate wording, that is not at issue here. In point of fact, the foregoing excerpts demonstrate that Appellant does satisfy both the written description and enablement prongs of the first paragraph of 35 U.S.C. §112 by describing how to make and use a “distal member” of Appellant’s “electrical operator”, as illustrated in at least three embodiments on 106(a), 107(a) and 108(a) in Figure 1, makes this rejection improper under both the “written description” and “enablement” requirements of the first paragraph. Appellant notes however, that there is no rejection under the second paragraph of §112 of claim 11 in the record before the Examining staff. Furthermore, the rejection is based upon a conclusory statement by the Examining staff; there is no evidence of record of an absence of either (i) a lack of enablement the subject matter of claim 11, of (ii) an absence of a written description the subject matter of claim 11, or (iii) a failure to

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<sup>14</sup> Claim 11, penultimate and last lines. With the elected species before the Examining staff, Appellant’s “obstructing said relative movement” may be achieved by causing the “different orientation” which may be either radial or rotational, depending upon both the design of the distal portion of the armature 106a, 107a, 108a, etc. and whether the winding of the coil is that of a solenoid, a rotary motor, or alternatively, a stepping motor, or alternatively, a combination of a radial and rotational change.

<sup>15</sup> Claim 11, penultimate and last lines.

disclose the best mode for practicing the subject matter of claim 11.<sup>16</sup> Consequently, in view of the satisfaction of the requirement for enablement of the phrases “distal member”, this rejection may not be sustained under the first paragraph of §112.<sup>17</sup>

**B. Appellant’s Originally Filed Specification Provides Both A Written Description And Enablement For The Subject Matter Defined By Claims 9 And 10**

**First**, Appellant notes that Paper No. 20080619 contains various assertions that infer that the use of the phrase *at least one*<sup>18</sup> in the Field, *et al.* ‘307 patent means *a plurality or more than one*. The Examiner has cited no authority under the statute to make this inference. Paper No. 20080619 has failed to demonstrate that the phrase *at least one*<sup>19</sup> as used in the Field, *et al.* ‘307 patent defines any number other than *one*. Attention of is invited to the complete absence of authority for the Examiner’s proposition that the phrase *at least one* means any number other than *one*. Appellant’s Figure 1, which displays an array of at least three electromechanical locking members 106a, 107a and 108a, **aligned in a linear array** illustrated, and comprised, of a plurality of locking members, all of which satisfy the

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<sup>16</sup> *High Concrete Structures, Inc. v. New Enter. Stone And Lime Co.*, 377 F.3d 1379, 71 USPQ2d 1948. 1951, WL 1689152 (Fed. Cir. 29<sup>th</sup> July 2004).

<sup>17</sup> Where the meaning of a claim is “reasonably discernable,” the claim is not indefinite. *Bancorp Servs., LLC v Hartford Life Ins. Co.*, 359 F.3d 1367, 69 USPQ2d. 1996 (Fed. Cir. 1<sup>st</sup> March 2004).

<sup>18</sup> Claim 1 of Field, *et al.* ‘307 reads, in part, “wherein *at least one* electromechanical locking member is disposed within the barrel ... .” Column 9, lines 5 and 6.

<sup>19</sup> Claim 1 of Field, *et al.* ‘307, column 9, lines 5 and 6.

definition of a locking member given by Field, *et al.* '307 in column 5, lines 1 through 8, and all or any one of which might be borne by Appellant's array of apertures 80, 82.

**Second**, Paper No. 20080619 also states that,

“the instant specification fails to provide support for the “at least one electromechanical locking member”<sup>20</sup>

Attention is invited to the illustrations in Figures, and especially Figure 1, where three distinct electromechanical locking members 106a, 107a and 108a are individually identified and described, and are collectively illustrated as an array. The structure and operation of each of these locking mechanisms are described in the originally filed specification. The attention of the Examining staff is invited to also note Appellant's express teachings in, among other features, that Integration of an electrical operator with a locking mechanism may be achieved by incorporation of one, or more, of electrical operators 105, 106, 107, 108<sup>21</sup> such as, to use the simplest of examples, the insertion of electrical operators 105b, 106b, 107b, 108b for pin tumblers 101b, or other types of tumblers,<sup>22</sup> into pin cylinders 80, 82<sup>23</sup>. Re-boring of one, or more, of pin cylinders 80, 82 may be necessary when retrofitting

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<sup>20</sup> Paper No. 53, page 2, paragraph 3.

<sup>21</sup> Page 22, beginning with line 18.

<sup>22</sup> With a concomitant re-bitting of the corresponding key to omit from the blade of the key any (or each) “tooth corresponding to the cylinder occupied by solenoid 105b”. See, page 20, line 21 and page 21, lines 1 and 2.

<sup>23</sup> Page 21, lines 8 through 11 and page 22, beginning with line 18., as illustrated by Figures 1 and 8A.

an existing lock; this will not require removal or other alteration of cylinder shell 102.<sup>24</sup> In short, Figure 1 illustrates a plurality of apertures (*e.g.*, pin cylinders 80, 82) and a plurality of solenoids 106b, 107b and 108b, together with a plurality of tumbler pins 101b. Alternatively, claims 90 and 120 may be practiced with but a single solenoid 106b, 107b or 108b. In short, there is no basis on the record before the Office to support the assertion of the Examining staff that “the instant specification fails to provide support for the ‘at least one electromechanical locking member’”;<sup>25</sup> moreover, the Examining staff has submitted to the prosecution history an administrative record that is singularly devoid of either citation supporting this assertion or other rationale justifying the assertion. This rejection may not therefore be sustained.

In view of these teachings, there is no evidence of record to establish a lack of an absence of either (i) a lack of enablement the subject matter of claims 90 or 120, of (ii) an absence of a written description the subject matter of claims 90 or 120, or (iii) a failure to disclose the best mode for practicing the subject matter of claims 90 or 120.<sup>26</sup> Consequently, in view of the satisfaction of the requirement for enablement of the phrase “distal member”,

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<sup>24</sup> Page 21, lines 8-11 expressly teach that “In a particular practice, the diameter of one of pin cylinders 80, 82 may not be sufficiently wide to accommodate a particular solenoid and will require re boring of the cylinder. The rebored plug can still be retrofitted into an already installed cylinder however, without the necessity of removing cylinder 102.”

<sup>25</sup> Paper No. 53, page 2, paragraph 3.

<sup>26</sup> *High Concrete Structures, Inc. v. New Enter. Stone And Lime Co.*, — F.3d ----, WL 1689152 (Fed. Cir. 29<sup>th</sup> July 2004).

this rejection may not be sustained under the first paragraph of §112.<sup>27</sup>

**Third**, the attention of the Examining staff is invited to the description of the *electromechanical locking member* given by Field, *et al.* ‘307:

“[a] plurality of electromechanical locking members 50, 52, 54 preferably are located within the central recess portion 42. The locking members are referred to as electroomechanical because, as described below, there are moved under the force of an electronically powered drive mechanism.”<sup>28</sup>

Wholly absent from Field, *et al.* ‘307 is any attribution of any electromechanical characteristic or property to elements 50, 52, 54; Field, *et al.* ‘307 describes elements 50, 52, 54 as passive, rather than active, components. In contradistinction, Appellant’s locking pin 201a is disclosed as a mechanical component made of a ferromagnetic material such as iron, that is moved under the force created by an electronically powered drive mechanism, namely coil 201b. Alternatively, Appellant’s “armature 106a”<sup>29</sup> contains at least one of the “grooves or slots 51, 53, 55” attributed by Field, *et al.* ‘307 to his “locking members 50, 52, 54.”<sup>30</sup> Wholly absent from Paper No. 52 is any explanation of why slots 51, 53, 55 in Field, *et al.* ‘307 provide enablement under the first paragraph of 35 U.S.C. §112 with each of elements 50, 52, 54 teaching “at least one electromechanical locking member”, while slots

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<sup>27</sup> Where the meaning of a claim is “reasonably discernable,” the claim is not indefinite. *Bancorp Servs., LLC v Hartford Life Ins. Co.*, 359 F.3d 1367, — USPQ2d. \_\_\_\_ (Fed. Cir. 1<sup>st</sup> March 2004).

<sup>28</sup> Field, *et al.* ‘307, col. 5, lines 65 through 67, and col. 6, lines 1 and 2.

<sup>29</sup> Shown in Figures 2 and 3.

<sup>30</sup> Field, *et al.* ‘307, col. 5, lines 5 and 6.

107c, 108h and grooves 105n of Appellant's electromechanical components 105D, 106a, 107a and 108a do not similarly provide enablement under the first paragraph of 35 U.S.C. §112 Appellant's electromechanical components into "electromechanical locking members", when Appellant's electromechanical components 105D, 106a, 107a and 108a are disclosed as responding to an electrically driven motor or solenoid by exhibiting movement relative to a detent, or to a sidebar, or other obstruction?

Absent any basis for the Examiner's inference <sup>31</sup>, Paper No. 52 fails to satisfy the standard required under 37 CFR §1.104, and is incomplete to the extent that Appellant can not reasonably and accurately comply with the requirement for a Request under 37 CFR §1.607. Accordingly, and in view of the absence of any evidence of record establishing an absence of enablement, this rejection should not be maintained absent completion of an administrative record in compliance with 37 CFR §1.104(a) and (b) which supports this rejection; Appellant has previously requested clarification, via a supplemental to Paper No. 20080619, containing:

- An explanation of the meaning of the phrase *at least one*, as used in Paper No. 20080619.
- Identification of authority that establishes that the phrase *at least one* indicates a number greater than one under the second paragraph of 35 U.S.C. §112.
- Identification of authority that supports the Examiner's explanation in the supplemental Paper No. 20080619 of the meaning of the phrase *at least one* stated by the Examiner.

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<sup>31</sup> See, for example, Paper No. 53, paragraph 3.

- A written explanation of the difference between an “electricomechanical locking member” and Appellant’s “armatures” and “locking pins”, as those terms pertain to this application.
- A written identification of the column and line number of Field, *et al.* ‘307 giving an explanation of any *electromechanical* property and characteristic of elements 50, 52 and 54 that defines a difference between an “electrical element”, as those terms pertain to this application.
- A written explanation by the Examiner of why slots 51, 53, 55 in Field, *et al.* ‘307 convert each of elements 50, 52, 54 into “at least one electromechanical locking member”, while slots 107c, 108h and grooves 105n of Appellant’s electromechanical components 105D, 106a, 107a and 108a do not similarly convert Appellant’s electromechanical components into “electromechanical locking members”, when Appellant’s electromechanical components 105D, 106a, 107a and 108a are disclosed as responding to an electrically driven motor or solenoid by exhibiting movement relative to a detent, or to a sidebar, or other obstruction?

These requested items of clarification have not been forthcoming; consequently, absent the requested clarification to the contrary, the record before the Examining staff conclusively establishes that more than one art-recognized noun may be used to describe features and components disclosed in Appellant’s application. In view of the foregoing explanation and demonstration of enablement under the first paragraph of 35 U.S.C. §112, these rejections should not be sustained. Such action is respectfully requested.

**C.     The rationale given in Paper No. 20080619 inaccurately interprets that explicit language of Applicant’s specification**

In the rationale given by Paper No. 20080619 in support of this rejection, the Examiner writes that,

“Secondly, the specification discloses that the *plurality* of locking members 106a, 107a, 108a are used alternatively and



not as a plurality within the same plug. See the specification on page 12, lines 11-13 which clearly recites the use of locking member 106a or 107a or 108a.”<sup>32</sup>

The passage of Applicant’s specification is a part of the *Detailed Description* that discusses the details of Applicant’s release mechanism which may be incorporated into Applicant’s “electromechanical locks”<sup>33</sup> and “the plugs and cylinders of electromechanical locks,”<sup>34</sup> and references those mechanisms to corresponding drawings. Where the Examiner’s rationale has erred is in the endeavoring by the Examining staff to inaccurately interpret the adjective *plurality* by reference to a re-phrasing of a single sentence taken, in isolation, from the entirety from the twenty-eight pages of Applicant’s original specification; this resulted in the erroneous interpretation now found in Paper No. 20080619.

In its entirety, the passage cited by the Examiner reads,

A release assembly such as a reciprocating solenoid coil 106b driving blocking armature 106a shown in greater detail in Figures 2 and 3, or a rotary motor 108b driving blocking armature, 108a shown in greater detail in Figures 4 and 5A and 5F, or the reciprocating solenoid coil 107b of blocking armature 107a shown in greater detail in Figures 6 and 7, resides within (typically cylindrical) chamber 80.”<sup>35</sup>

The structure of this passage is written in the disjunctive in order to teach the differences of structure between these constituent components. Moreover, a subsequent sentence within

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<sup>32</sup> Paper No. 20080619, ¶3.

<sup>33</sup> Original specification, page 1, line 11.

<sup>34</sup> Original specification, page 1, line 11.

<sup>35</sup> Original specification, page 12, lines 11-15.

the same paragraph writes about Applicant's release assemblies 106, 107, and 108 in the conjunctive, aggregately, by stating that:

“Release assemblies 106, 107, and 108 are electrically connected to an electronic logic and control circuit 104b encapsulated within an electrically insulated casing 104 formed to define an outer sector of cylindrical plug 101.”<sup>36</sup>

Still other passages describe these constituent components either disjunctively, or conjunctively; these teachings by Applicant's original specification is an affirmative rebuttal of the Examiner's assertion that one passage of Applicant's specification constitutes a disclaimer of the subject matter of the alternative of the issue of enablement, and the scope of rejected claims 9 and 10.

The fatal flaw in the Examiner's rationale is that the Examiner is making an untimely argument that Applicant is precluded from recapturing “specific meanings disclaimed during prosecution”<sup>37</sup>, despite the fact that prosecution of the above-captioned application has yet to conclude.<sup>38</sup> Moreover, in a decision that dwelled upon the correct methodology for judicial interpretation of the language of patent claims, *Festo Corp. v. Shoketsu Kinzoku*

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<sup>36</sup> Original specification, page 12, lines 120 and 21, and page 13, line 1.

<sup>37</sup> *Mangosoft, Inc., et al. v. Oracle Corporation*, slip opinion, p. 11.

<sup>38</sup> The issue argued by Paper No. 20080619 is whether Applicant has made a disclaimer or estoppel of Applicant's right to for pending claims 90 and 120 to cover an embodiment which may cover a plurality of those constituent components. This is not an issue to be addressed at this stage of the examination under the first paragraph of 35 U.S.C. §112; rather Paper No. 20080619 should instead focus upon whether Applicant's original specification provides enablement of one of ordinary skill in the art to both make and to use an embodiment which may cover a plurality of those constituent components?

*Kogyo Kabushiki*, 520 U.S. 111 (1979), the claims defined *sealing rings* in the plural, but the accused device had but a single sealing ring. Subsequently, in *Dayco Products, Inc. v. Total Containment, Inc.*, the Federal Circuit recognized that, in context, the plural can describe a universe ranging from one to some higher number, rather than requiring more than one item.<sup>39</sup> In other words, the plural can, and under the first paragraph of 35 U.S.C. §112 lawfully does describe the singular, and *vice-versa*, a disclosure of the singular constituent element enables a plurality of that constituent element.

This holding in *Dayco Products, Inc.* about the enablement of the plural by a disclosure of a single species was again repeated by the Federal Circuit in its decision in *Versa Corporation v. AG-Bag International Limited*.<sup>40</sup> 392 F.3d 1325 (Fed. Cir. 2004).

Consideration should also be given to the efforts of the Commissioner to argue that “partial figures ... [which] do not show every leg’s offsets and their displacement” in *In re Robert Skvorecz*, \_\_\_ F.3d \_\_\_ (Fed. Cir. 3 September 2009), is not a lawful basis for the finding by the Board “that the claim element ‘**a plurality of offsets located** ... located in said first rim’ is not described in the specification ... .”

In summary, Applicant has demonstrated an affirmative enablement of a plurality of constituent components of Applicant’s locking mechanism, the absence of any disclaimer of any disclaimer or estoppel of Applicant’s right to for pending claims 9 and 10 to cover an

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<sup>39</sup> *Dayco Products, Inc. v. Total Containment, Inc.*, 258 F.3d 1317, 1328 (Fed. Cir. 2001).

<sup>40</sup> *Versa Corporation v. AG-Bag International Limited*. \_\_\_ F.3d \_\_\_ (Fed. Cir. 2004).

embodiment which may cover a plurality of those constituent components, and enablement of one of ordinary skill in the art to both make and to use an embodiment which may cover a plurality of those constituent components. Consequently, Paper No. 20080619 fails to make a *prima facie* showing of a lack of enablement by Applicant's original specification of an embodiment which may cover a plurality of *locking mechanisms*. This rejection should not, therefore, be sustained. Such action is respectfully urged.

### **Rejection under 35 U.S.C. § 103**

Claims 9 and 10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gokcebay, U.S. Patent No. 5,552,777 in view of Thordmark *et al.*, U.S. Patent No. 5,542,274 and Naveda, U.S. Patent No. 4,416,127. Applicant respectfully traverses this rejection for the following reasons.

#### **Claim 9**

**First**, the proposed combination fails to make a *prima facie* showing of obviousness. Specifically, the proposed combination is singularly devoid of any teaching or suggestion of Applicant's:

“an electronically powered drive mechanism cooperating with the electromechanical locking member to selectively move the locking member from the barrel blocking position to the non-barrel blocking position in which the side bar engages the locking member to rotate the barrel and operate the lock.”

Furthermore, neither the primary reference nor the secondary reference show any interaction between:

- “an electromechanical locking member substantially entirely contained with the barrel member,” or
- “an electronically powered drive mechanism cooperating with the electromechanical locking member to selectively move the locking member ... [to a] position in which the side bar engages the locking member,” or
- “an electronically powered drive mechanism cooperating with the electromechanical locking member to selectively move the locking member from the barrel blocking position to the non-barrel blocking position ... ,” or
- “an electronically powered drive mechanism cooperating with the electromechanical locking member to selectively move the locking member from the barrel blocking position to the non-barrel blocking position in which the side bar engages the locking member.”

In short, the Examiner’s proposed combination can not alter the primary reference to incorporate the foregoing features of claim 9 without impermissibly preventing the primary reference for operating in its intended mode in which “bore or recess 50 into which the blocking pin 38 extends in the blocking position.” Gokcebay ‘777, column 6, lines 45 and

46.

The fact that Examining staff has repeatedly ignored, and continues to fail to grasp this deficiency in the Examiner's proposed combination, is itself convincing evidence of non-obviousness.

Moreover, the simple observation that any cooperation of the "small solenoid 36" of Gokcebay '777" with a side bar would impermissibly prevent Gokcebay '777 from operating in its intended mode in which "bore or recess 50 into which the blocking pin 38 extends in the blocking position," as is described by Gokcebay '777, column 6, lines 45 and 46, is therefore, convincing and persuasive indicia of the non-obviousness of claim 9.

#### **Claim 10**

The Examiner's proposed combination fails to make a *prima facie* showing of obviousness. Specifically, the proposed combination is singularly devoid of:

- claim 10's "an electromechanical locking member ... substantially entirely contained within the barrel member," or
- claim 10's "electronically powered drive mechanism located within the barrel member moving the electromechanical locking member to a position in which the groove of the locking member is aligned to receive the side bar."

Any modification of the primary reference to meet either of these features, would impermissibly preventing the primary reference for operating in its intended mode in which

“bore or recess 50 into which the blocking pin 38 extends in the blocking position.”  
Gokcebay ‘777, column 6, lines 45 and 46.

The fact that Examining staff has repeatedly ignored, and continues to fail to grasp this deficiency in the Examiner’s proposed combination, is itself convincing evidence of non-obviousness.

Moreover, the simple observation that any cooperation of the “small solenoid 36” of Gokcebay ‘777” with a side bar would impermissibly prevent Gokcebay ‘777 from operating in its intended mode in which “bore or recess 50 into which the blocking pin 38 extends in the blocking position,” as is described by Gokcebay ‘777, column 6, lines 45 and 46, is therefore, convincing and persuasive indicia of the non-obviousness of claim 10.

### **Claims 9 and 10**

**Third**, Applicant notes that the Examining staff applied the same combination of art to Applicant’s copending divisional application, Serial No. 08/720,070. There, Applicant observed that the rejection is untenable under 35 U.S.C. §103(a) when the Examiner’s proposed combination of Gokcebay, U.S. Patent No. 5,552,777 modified according to Thordmark *et al.*, U.S. Patent No. 5,542,274 and Naveda, U.S. Patent No. 4,416,127, is carefully considered. Accordingly, Applicant respectfully traverses this rejection for the following reasons:

The proposed combination is improbable, is unsupported by any evidence of motivation in the record before the Examiner, and fails to provide a *prima facie* showing of

obviousness; the Examiner is respectfully urged to refuse to sustain this rejection for the following reasons.

**A. The Rejection Under 35 U.S.C. §103 Errs By Considering The Individual Component References Of The Proposed Combination Piecemeal, And Thus Failing To Consider The Proposed Combination As A Single Entity**

In assembling the three exemplars of the art drawn to form the Examiner's proposed combination, Paper No. 20080621 makes a piecemeal consideration each reference, and merely identifies individual teachings about those references, thus failing to consider the proposed combination. By way of example of the flaw in this failure, Paper No. 20080619 erroneously reasons that,

“Naveda reinforces that one having ordinary skill in the art ... would have known of the versatility and interchangeability of known elements usable in verifying and actuating electric lock cylinders including among others, miniature coils, miniature electromagnets, electronic memories [*sic* ,] bioelectric circuits, resistance plates and the like (col. 3, line 1-13 and col. 4, lines 30-35).”

Based upon this casuistry, Paper No. 20080619 erroneously concludes that therefore,

“It would have been obvious to one of ordinary skill in the art to replace the simple blocking element of Gokcebay with the multi-part electrically actuated blocking element of Thordmark *et al.* to thwart natural attempts to force system locks that are equipped with electronic blocking functions, of the kind meant by Thordmark (col. 1, lines 38-42), by making forcing of such locks more difficult. It would have further been an obvious reversal of parts and change of size to select miniature logic circuitry and a miniature solenoid and locking member 11 such that the blocking mechanism fits within a conventional sized lock plug as taught by Gokcebay and Naveda.”

The fallacy of Paper No. 20080619's casuistry lies in the observation that regardless of the



use of the term “miniaturization” by the proposed combination, the source of this term, Naveda ‘127, teaches “a practical embodiment” that, as illustrated by Naveda ‘127’s Figure 10, three (3) parallel rotating shafts, as opposed to the single rotating cylinder plugs of Applicant’s, Gokceby U.S. 5.522.77 and Thordmark U.S. 5.542.274. Utterly unexplained in Paper No. 20080619 is precisely how a tripling of the number of parallel rotating components might be said to teach “miniaturization” in any sense of that word?

Moreover, in the Examiner’s proposed combination, nothing teaches either:

“an obvious reversal of parts and change of size”; or

“an obvious ... change of size; or

how “to select miniature logic circuitry and a miniature solenoid and locking member 11 such that the blocking mechanism fits within a conventional sized lock plug.”

Although these deficiencies in the Examiner’s proposed combination are merely exemplary of the inadequacy of the prior art to render Applicant’s claims obviousness, these deficiencies illustrating the glaring incompleteness of in the Examiner’s refusal to consider the “subject matter sought to be patented as a whole” and the “differences between the subject matter sought to be patented and the prior art” as is mandated by 35 U.S.C. §103(a).

Equally unclear is why the pending claims raise questions of “reversal or parts” or “change of size” or whether the practice of the pending claims would raise an issue of whether embodiments of these claims would provide a “blocking mechanism fits within a conventional sized lock plug”? Applicant submits that the Examiner appears to have lost sight of the definitions of the pending claims as well as the explicit requirement of 35 U.S.C.

§103(a).

Applicant further submits therefore, and ignoring *arguendo* the absence of any teaching for making the Examiner's proposed combination except an impermissible hindsight reconstruction in the light provided by Applicant's rejected claim, Applicant's pending claims define a patentably distinguishable structure, and process, constructed of non-obvious constituent components. Where, for example, in the Examiner's proposed combination, is Applicant's "*locking mechanism disposed with said apertures ... obstruction said reciprocation [of said sidebar]*" in combination with Applicant's "*electrical operator disposed within one of said apertures ... obstructing said relative movement [between the cylinder and said plug]*", as defined by claim 1? These deficiencies in the art are glaring, and scream against the Examining staff's inadequate compliance with 35 U.S.C. §103(a). Consequently, the explicit teachings of the Examiner's proposed combination fail to provide the combination asserted by Paper No. 20080619.

**B. The Rejection Under 35 U.S.C. §103 Ignores The Explicit Requirements Of 35 U.S.C. §103(a) For A Showing Of Obviousness**

The Examiner should pause to consider that applicant's claim 1, by way of example, is not the type of claim found in *KSR Int'l Co. v. Teleflex Inc.*<sup>41</sup> were every element, that is, both the electrical switch and the brake petal assembly, were standard off-the-shelf items that had been previously used in the same industry, for the same purpose, for many years, to achieve the same result. In *KSR*, neither the claim when read in its entirety, nor the two

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*KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1739, 82 USPQ2d @1395 (2008).

paragraphs that defined the switch and assembly, did anything more. Consequently, and in conformance with the precedential principles laid down by *Hotchkiss v. Greenwood*,<sup>42</sup> affirmed its principle of the “functional approach” that “[t]he combination of familiar elements according to known method is likely to be obvious when it does no more than yield predictable results.”<sup>43</sup>

Here, and unlike *KSR*, the Examining staff has failed to show that not even one of the constituent elements of Applicant’s claims 9 or 10 has ever been known in the art, and has failed to show either the structure of Applicant’s claim 9:

- “an electronically powered drive mechanism cooperating with the electromechanical locking member to selectively move the locking member from the barrel blocking position to the non-barrel blocking position in which the side bar engages the locking member to rotate the barrel and operate the lock,” or
- “an electromechanical locking member substantially entirely contained within the barrel member,” or
- “an electronically powered drive mechanism cooperating with the electromechanical locking member to selectively move the locking member ... [to a] position in which the side bar engages the locking member,” or

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<sup>42</sup> *Hotchkiss v. Greenwood*, 11 Howard 248.

<sup>43</sup> *Ex parte Mary Smith*, Appeal No. 2007-1925 (BPAI 2007).

- “an electronically powered drive mechanism cooperating with the electromechanical locking member to selectively move the locking member from the barrel blocking position to the non-barrel blocking position ... ,” or
- “an electronically powered drive mechanism cooperating with the electromechanical locking member to selectively move the locking member from the barrel blocking position to the non-barrel blocking position in which the side bar engages the locking member,”

or Applicant’s claim 10’s:

- “an electromechanical locking member ... substantially entirely contained within the barrel member,” or
- “electronically powered drive mechanism located within the barrel member moving the electromechanical locking member to a position in which the groove of the locking member is aligned to receive the side bar.”

These structural features and the foregoing results attained by these operational functions performed by this structure of claims 9 and 10 have never existed in the art outside of Applicant’s specification. The Examiner is urged to consider that the procedural standard established by 35 U.S.C. §103(a) requires that “the *differences* between the subject matter sought to be patented and the prior art” must be identified; that standard has not been met

here where the outstanding Office action as attributed to the Examiner's proposed combination the nomenclature, operational functions and results attained when these properties can not be found by a thorough reading of that proposed combination. To paraphrase the Board of Appeals, how may this art be said to teach these features of claims 9 or 10 when that art does not use the words of claims 9 or 10?

These deficiencies in the art are the "differences" which must be identified under 35 U.S.C. §103(a). Absent any identification of these "differences" in the administrative record for this application, the procedural standard of 35 U.S.C. §103(a) has not been met. Consequently, there is no *prima facie* showing of obviousness on the administrative record before the Office. Withdrawal of this rejection is therefore respectfully urged.

**C. The Rejection Under 35 U.S.C. §103 Fails To Make A *Prima Facie* Showing Of Obviousness**

According to MPEP 706.02(j), the following establishes a *prima facie* case of obviousness under 35 U.S.C. §103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

These standards imposed by MPEP §706.02(j) are not met, as is demonstrated by the

following cursory review of the explicit language of the pending claims.

**Third**, the earlier noted fact that the Examiner's proposed modification of the primary reference would prevent the primary reference from being operated in its intended mode of operation, is itself convincing *indicia* of the non-obviousness of these claims.<sup>44</sup>

**Fourth**, there is no evidence of record for modifying the primary reference in the manner asserted by the Examiner, except through a hindsight reconstruction of the art in the light provided by Appellant alone. In the Examiner's proposed combination, only Thordmark '274 discloses a movable locking member cooperating with any electrical operator; that movable locking member 11, as well as "latching member 10", is however, borne by the cylinder shell, and not, as defined by Appellant's claims, borne by, or mounted upon, the plug. Naveda '127, which is a rather large case lock, in terms of the physical volume occupied by shell, or housing, of the lock in comparison to the primary reference, is utterly devoid of any cylinder plug, is bereft of a suggestion of a detent or sidebar, and contributes nothing to this proposed modification of the primary reference.

Moreover, Naveda '127 requires at least a width adequate to accommodate three (3) radially spaced-apart axes, unlike any of the other references.

In short, there is no evidence of record showing motivation for making the Examiner's proposed combination, and Naveda '127 does nothing to suggest miniaturization or other

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The Examiner's proposed combination would impermissibly prevent the primary reference from operating in its intended mode of operation by obstructing the ability of the "block pin 38" of "small solenoid 36" of the primary reference to engage its cylinder shell 46.

remedy these deficiencies noted in the primary and secondary references. The Federal Circuit has repeatedly emphasized that:

“[t]he test for obviousness is not whether the features of one reference may be bodily incorporated into another reference... Rather, we look to see whether combined teachings render the claimed subject matter obvious.” *In re Wood*, 599 F.2d 1032, 202 USPQ 171, 174 (CCPA 1979) (citing *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549-50 (CCPA 1969); *In re Mapelsden*, 329 F.2d 321, 322, 141 USPQ 30, 32 (CCPA 1964).

Here, there is no actual teaching in the Examiner’s proposed combination for shifting “a spring biased sidebar 10” anywhere; the primary reference does not require a sidebar and can not fit a sidebar between its blocking pin 38 and its recess 50 without interfering with functional operation; Thordmark ‘274 already has a “side-bar 7” which has no disclosed relation with its “electronic operator 12”; and Naveda ‘127 neither discloses nor indicates any need for a sidebar, whether biased or unbiased.<sup>45</sup> Absent the requisite evidence of motivation for making the Examiner’s proposed combination, this rejection may not be sustained.<sup>46</sup>

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<sup>45</sup> The Examiner’s reliance upon Naveda ‘127 as ostensibly teaching miniaturization is evidence of a misguided understanding of the relevant art: the structure of the case lock taught by Naveda ‘127 is necessarily huge, and substantially external to any cylinder component, when compared to the cylinder locks of Appellant and the primary reference.

<sup>46</sup> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. ... The teaching or suggestion to make the claimed combination and the reasonable expectation of success ***must both be found in the prior art and not based on Appellant’s disclosure***. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Emphasis added.

Alternatively, if the Examiner has intended to assert that the proposed combination may be constructed with a wholesale substitution of “electrical operator 12, a movable electronic [*sic*] locking member 11” and latch 10 for the primary reference’s “electrical operator 36 ... [and] member 38”, the Examiner’s proposed combination is flawed because it impermissibly prevents the primary reference from operating in its intended mode of operation with “a bore or recess 50 [drilled into, or preferable through cylinder shell 46] into which blocking pin 38 extends in the blocking position” (*i.e.*, to directly and securely engage the cylinder shell) and concomitantly impermissibly prevents the primary reference from retentively holding “blocking pin 38” in a retracted position when energized.<sup>47</sup> There is no evidence of record teaching this construction and concomitant modification of Gokcebay ‘777, except that provided by Appellant’s claims alone among the art.<sup>48</sup> The mandate for completeness in the administrative record set forth 37 CFR §1.104(a), (b) and (c) has not been met here because Paper Nos. 39 and 53 fail to explain how the proposed combination might be constructed to preserve the teaching of the primary reference for “a bore or recess

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<sup>47</sup> Under U.S. practice, these teachings of Gockebay ‘777 may not be ignored by the Examiner when constructing the proposed combination. According to MPEP §2141.02, “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Construction of the Examiner’s proposed combination to eliminate these features of Gockebay ‘777 is improper under 35 U.S.C. §103(a).

<sup>48</sup> The Examiner’s “obvious reversal of parts and change of size to select miniature logic circuitry and a miniature solenoid and locking member 11 such that the blocking mechanism fits with a conventional sized lock plug as taught by Gokcebay and Naveda” is fictitious and illusory, because there is no evidence of record which either teaches or suggest the “obvious reversal.”



50 [drilled into, or preferable through cylinder shell 46] into which blocking pin 38 extends in the blocking position” (*i.e.*, to directly and securely engage the cylinder shell) and concomitantly impermissibly prevents the primary reference from retentively holding “blocking pin 38” in a retracted position when energized. Clarification was previously requested, but was not provided. Consequently, the record before the Examiner does not support this rejection. Refusal to sustain this rejection is respectfully requested.

Under 35 U.S.C. §103(a),

“combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability. *In re Dembiczak*, 175 F.3d 994, 50 USPQ.2d 1614 (Fed. Cir. 1999).

Consequently, this alternative construction is untenable, not only because it impermissibly prevents the primary reference, as modified by the two secondary references, from operating in its intended mode of operation, but also because neither of the two secondary references provide the specific motivation to construct Appellant’s “a plug” with, among other features, “a detent disposed between said plug and a cylinder ... an electrical operator borne by ... and rotating with said plug ... releasing said detent to move ... .” Given this failure of a *prima facie* requisite showing of the obviousness under the criteria of §706.02(j) of the *Manual*,<sup>49</sup> the Examiner is respectfully requested to refuse to sustain this rejection.

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<sup>49</sup> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. ... The teaching or suggestion to make the claimed combination ... ***must ... be found in the prior art and not based on Appellant's disclosure.***

In other words, the record fails to show either a *prima facie* teaching or obviousness or motivation necessary to construct the Examiner's proposed combination. The Examiner is therefore urged to refuse to sustain this rejection.

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In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

## CONCLUSION

**First**, there is no evidence of record of an absence of either (i) a lack of enablement the subject matter of claim 9 or 10 of (ii) an absence of a written description the subject matter of claim 9 or 10, or (iii) a failure to disclose the best mode for practicing the subject matter of claim 9 or 10.<sup>50</sup> Under U.S. practice, “the examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.”<sup>51</sup> That initial burden has not been met; consequently, in view of the satisfaction of the requirement for enablement of the phrases “distal member”, this rejection may not be sustained under the first paragraph of §112.<sup>52</sup>

**Second**, under *Geneva Pharmaceuticals, Inc. v. Glaxo SmithKline PLC*, 349 F.3d 1373, 68 USPQ2d 1865 (Fed.Cir. 21<sup>st</sup> November 2003), 35 U.S.C. §121 bars an obviousness-type double patenting rejection when (i) each claim of Appellant ‘601 patent appeared in the instant application, (ii) the Examiner actually imposed, maintained, and continues to maintain a requirement under 37 CFR §1.146 for an election of species, arguing that no generic claims were allowable, and (iii) Appellant’s filed a divisional application was filed

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<sup>50</sup> *High Concrete Structures, Inc. v. New Enter. Stone And Lime Co.*, 377 F.3d 1379, 71 USPQ2d 1948. 1951, WL 1689152 (Fed. Cir. 29<sup>th</sup> July 2004).

<sup>51</sup> *MPEP*, 8<sup>th</sup> Ed., Rev.3 (August 2005) §2163, citing *Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976).

<sup>52</sup> Where the meaning of a claim is “reasonably discernable,” the claim is not indefinite. *Bancorp Servs., LLC v Hartford Life Ins. Co.*, 359 F.3d 1367, 69 USPQ2d. 1996 (Fed. Cir. 1<sup>st</sup> March 2004).

to present claims which were indicated by the Examiner to be allowable in the above-captioned application, and those claims were passed to issue in Appellant's '601 patent. This rejection of claims 9 and 10 may not therefore, be maintained under the doctrine of obviousness type double patenting.

**Third**, turning now to the issue of obviousness of claims 9 and 10 under 35 U.S.C. §103(a) over the Examining staff's proposed combination of Gockebay '777, Thordmark '274 and Naveda '127, 35 U.S.C. §103 requires consideration of whether the differences between the subject matter defined by each pending claim and the prior art are such that the "subject matter as a whole" would have been obvious? Under U.S. practice, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266, n.14, 23 USPQ2d 1780, 1783-84, n.14 (Fed Cir. 1992), citing *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). It is further established that the Examiner must make specific findings on a suggestion to combine prior art references. *In re Dembiczak*, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

As demonstrated the by foregoing paragraphs, the Examiner has focused not on the subject matter of Appellant's claims as a whole, but has focused upon individual limitations. Ostensibly, the prior art relied upon by the Examiner endeavors to provide a lock that may be easily retrofitted. Gokcebay '777 however, requires that a bore 50 be drilled within the shell of the existing lock while Thordmark '274 requires that a separate V-shaped groove 3c

that is spaced-apart and distinct from the slot for sidebar 7, be machined within the cylinder, and that the entire recess shown in Figure 1 be machined into the shell.

Contrary to the Examiner's assertions, neither Naveda '127 nor Thordmark '274 nor Gockebay '777 advocates both insertion of an electrical operator into the cylinder plug and some interaction between that plug borne operator and a bar, elongated member or sidebar that is able to make simultaneous engagement of both the shell and cylinder plug, because:

- Gockebay '777 teaches only insertion of a solenoid within the cylinder,
- Gockebay '777 is wholly devoid of any bar (other than the armature 18 that is itself a part of solenoid 17),
- Gockebay '777 is wholly devoid of any bar that provides any type of engagement between the shell and cylinder,
- Thordmark '274 teaches nothing about insertion of any operator within the cylinder,
- both Gockebay '777 and Thordmark '274 require not only complete replacement of the cylinder, but major alteration of the shell in order to accommodate a retrofit,
- both Gockebay '777 and Thordmark '274 are utterly incapable of providing any interaction with their primary locking mechanical features, and
- Naveda '127 is singularly devoid of any teaching of a cylinder plug and discloses no primary mechanical locking mechanism as is required by both Gockebay '777 and Thordmark '274,
- Naveda '127 fails to describe how traveling coil 17, armature 18 and latching

element 10 of Fig. 7 of Thordmark '274 incorporated into the plug of Gockebay '777.

Nowhere does the Examiner explain, and the art is silent, how the three parallel rotational members of Naveda '127, each of which requires a unique, spaced-apart axis of rotation, might be viewed to teach "miniaturization" of the single axis compact structures of the proposed combination. Of necessity, Naveda '127 teaches the antithesis of miniaturization asserted by the Examiner.

In contradistinction, Appellant's claims define a structure with an electrical operator borne by the cylinder plug, a member moving in response to the operator, and interaction between the operator and a side bar, elongate member or sidebar interposed between the shell and the cylinder plug. Although these differences may appear to be but a small advance in the art, the advantages flowing from these differences are substantial. For example, only Appellant's claims define a structure with an electronic operator borne by the cylinder plug that interacts with a side bar and that consequently, is able to advantageously both retrofit an installed lock by the expedient of replacing only the cylinder plug *without any* alteration of the shell and to *interact or cooperate with* an existing sidebar of a primary mechanical locking mechanism that is positioned between the shell and plug. The fact that both Gockebay '777 and Thordmark '274 are concerned with retrofitting of existing locks, a fact noted by the Examiner, and that both references require modification of the shell of the lock in order to complete that retrofitting, while Appellant alone provides a cylinder plug that may work with an existing sidebar and may be retrofit without any modification of the shell is a difference between the prior art and the structure defined by the pending claims that

prevents the subject matter as a whole from being obviousness under 35 U.S.C. §103. This deficiency in the Examiner's proposed combination is not remedied by Naveda '127. Moreover, this deficiency is highlighted by the fact that Thordmark '274 clearly avoids either teaching or suggestion of any interaction or cooperation between sidebar 7 and coil 17.

This interaction with the existing sidebar beneficially enhances the security provided by Appellant's lock. Neither Gockebay '777, Thordmark '274 nor Naveda '127, nor the Examiner's proposed combination of Gockebay '777, Thordmark '274 and Naveda '127 are able to provide these advantages. Moreover, the Examiner's proposed combination is incomplete and fails to make a *prima facie* showing of obviousness; how, for example, is the traveling coil 17, armature 18 and latching element 10 of Fig. 7 of Thordmark '274 incorporated into the plug of Gockebay '777? No details of such a combination are provided by the Examiner's proposed combination. Accordingly, in view of these differences between the pending claims and the prior art, "the subject matter as a whole" can not be found to be rendered obvious under 35 U.S.C. §103(a). In short, the Examiner has unfairly sought to limit the scope of coverage to which Appellant is entitled by reconstructing the art in an effort to meet the terms of Appellant's claims when none of that art suggests such a simple modification of the art as Appellant's electrical operator being both borne by and rotating with the cylinder plug *and* operating to block the travel of a sidebar. Evidence of that error in the formation of the Examiner's proposed combination lies in the fact that the proposed combination is depends upon a primary reference that discloses numerous embodiments of an invention, but none of those several embodiments derive any advantage from the

modifications required to construct the Examiner's proposed combination; those modifications simply produce a more cumbersome structure with more parts that accomplishes nothing that the primary reference does not achieve without those modifications. This is evidence of a lack of motivation in the art to make the modifications necessary to construct the Examiner's proposed combination, as well as evidence that the Examiner is simply using Appellant's claims as a blueprint in an impermissible effort to make a hindsight reconstruction of the art.

Perhaps the proposed combination of Gokcebay 777, Thordmark, *et al.* '274 and Naveda '217 was formed on the reverse side of the "looking glass", out of sight of the intrinsic limitations of the proposed combination, guided only by Appellant's contribution to the art, and without consideration of the pending claims in their entirety:<sup>53</sup>

- By way of example, the Examiner's proposed combination including Gokcebay 777 is not a pioneering patent. Gokcebay '777 itself teaches, at some length, that it is an improvement over Appellant's earlier U.S. Patent No. 5,140,317.<sup>54</sup> Gokcebay '777 however, in seeking to improve upon Mr. Hyatt's, that is, the Appellant's, earlier efforts in the art, places a premium

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<sup>53</sup> 35 U.S.C. §103(a) mandates consideration of the *subject matter as a whole* in a determination of obviousness. A point-of-novelty test is improper.

<sup>54</sup> Gokcebay, *et al.*, '777, see the entirety of column 2, lines 7 through 54, devoted to an analysis by the Examiner's primary reference, of Appellant's earlier U.S. Patent No. 5,140,317.



upon extreme compactedness<sup>55</sup> of his electronic access control that is physically irreconcilable with the demands of the secondary references for unrestricted axial length of its “mutually independent lock functions.”<sup>56</sup> The primary reference, in his efforts to follow the teachings of Appellant, concentrates his structure within his cylinder plug 24 to offer a structure “in an extremely compact fashion”<sup>57</sup> for which “[n]o additional space is required to implement the system of the invention.”<sup>58</sup> The Examiner’s proposed combination however, as represented by Thordmark, *et al.* ‘274 and Naveda ‘217, dwells wholly outside the cylinder plug and demands,

“a latching element 10 [the configuration of which] can vary within wide limits ... [and] its length may vary but preferably it exceeds half the axial length of the plug and may – as in the illustrated embodiments — often substantially correspond to the axial length of the plug.”<sup>59</sup>

This disharmony, attributable to both the radial versus axial orientation in the

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<sup>55</sup> Gokcebay, *et al.*, ‘777, see column 3, lines 1 through 5, as well as column 4, lines 39 through 41.

<sup>56</sup> Thordmark, *et al.* ‘274, column 2, lines 66 and 67, and column 3, line 9.

<sup>57</sup> Gokcebay, *et al.*, ‘777, see column 4, line 39.

<sup>58</sup> Gokcebay, *et al.*, ‘777, see column 4, lines 41, 42. As taught by the primary reference, his lock “has an electronic access feature which occupies no more sapce than the mechanical lock itself. **Nothing** is required outside the lock cylinder ... **aside from** a small recess or bore [*i.e.*, bore 50] which is provided in the cylinder shell.” Gokcebay, *et al.*, ‘777, see column 3, lines 1 through 5.

<sup>59</sup> Thordmark, *et al.* ‘274, see column 6, lines 18 through 25, together with column 4, lines 20 through 23.

primary and secondary references, as well as to the gross differences in size relative to the cylinder plug in the primary and secondary references, and to the insistence of the primary reference that “[n]othing is required outside the lock cylinder”<sup>60</sup> versus the demand of the secondary references that all moving parts be required to be on the outside of the lock cylinder, is irreconcilable, and impermissibly prevents the primary reference from being practiced in its intended mode of operation, contrary to the practice under 35 U.S.C. § 103(a). Consequently, the primary reference may not be modified according to the teachings of the secondary references.

- By way of a second example, Gokcebay ‘777 dwells upon direct engagement between the cylinder plug and its surrounding shell in an effort to provide, “in an extremely compact fashion, electronic access control to a conventional mechanical lock”<sup>61</sup> with “a bore or recess 50 [cut into cylinder shell 46] into which the blocking pin 38 extends in the blocking position.”<sup>62</sup> In the Examiner’s proposed combination including Thordmark, *et al.* ‘274, the entirety of “latching element 10” having a certain axial length, “coacts with a blocking element” 11 which is “conveniently moved axially by means of an electric motor, an electromagnet, a solenoid ...” is encased within “a lock

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<sup>60</sup> Gokcebay *et al.* ‘777, see column 3, lines 2 and 3.

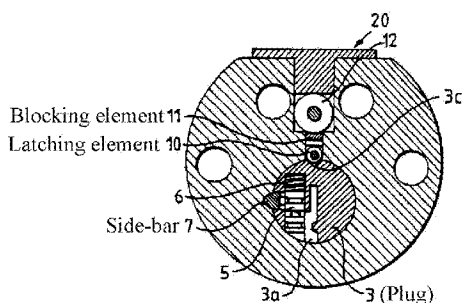
<sup>61</sup> Gokcebay, *et al.*, ‘777, see column 4, lines 39 and 40.

<sup>62</sup> Gokcebay, *et al.*, ‘777 see column 6, lines 45 through 48.

cylinder 2”, to indirectly engage “plug 3”; this entirety is taught by the Examiner’s proposed combination to be one of two, or more, “**mutually independent** latching or blocking devices.”<sup>63</sup>

**Thordmark et al. U.S. Patent No. 5542274**

**Figure 3**



Completely absent from the Examiner’s proposed combination is any direct locking, or latching, or blocking function achieved between “lock cylinder 2” and “plug 3” with the direct engagement taught by the primary reference, because the proposed combination teaches that its electrically activated latching or blocking device is devoid of either structural or functional relation to “side-bar 7.”

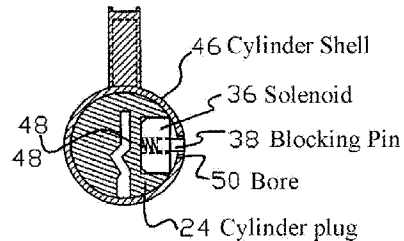
This divergence by the secondary references from the teaching by the primary reference of a solenoid to achieve direct engagement between the cylinder plug 24 and bore 50 in the surrounding cylinder shell 46,

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<sup>63</sup> Thordmark, *et al.* ‘274, column 2, lines 66 and 67, and column 3, lines 8 through 10.

**Gokcebay et al. U.S. Patent No. 5552777**

**Figure 5**

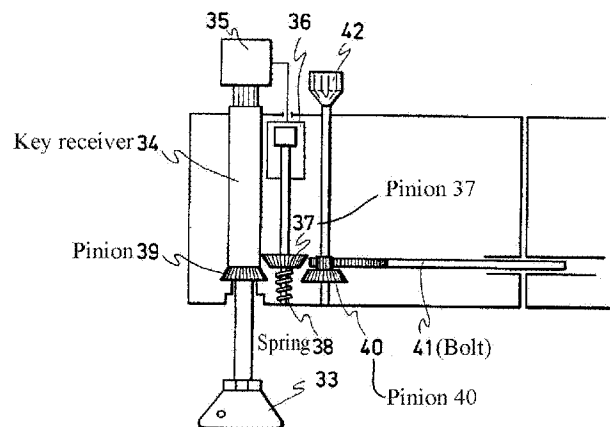


in addition to irreconcilability between the teachings of the primary reference on “extremely compact fashion” and the demand by the secondary references in the proposed combination for a latching element 10 of a certain axial length, deprives the prior art of all evidence of motivation for making the Examiner’s proposed combination. The various teachings of the several component references in the Examiner’s proposed combination are irreconcilable on the features defined by the finally rejected claims. Although the prior art may contain all of the constituent parts of the rejected claims, not only is that art devoid of motivation to combine those parts in the manner defined by these claims to cooperate in the relationships set forth by these claims, but the teachings of that art are irreconcilable on the precise points of mutual independence of lock functions, compactedness and direct, versus indirect, engagement between the lock cylinder 2 and plug 3, where that art differs between the pending claims. In view of such advantageous results flowing from these differences such as Appellant’s preservation of compactness and enabling retro-fitting without a need to

cut a bore 50<sup>64</sup> into the shell in the manner required by the primary reference, these rejections may not be sustained under 35 U.S.C. §103(a).

- By way of further example, the Examining Staff makes much of the teaching in the Examiner's proposed combination including Naveda '127 in the proposed combination,

**Naveda U.S. Patent No. 4416127  
Figure 10**



despite the fact that all, and every single one of the moving parts of Naveda '127, namely pinion 39, pinion 37, spring 38, pinion 40, bolt 41, and the various unnumbered shafts, are all located wholly outside the circumference of key receiver 34,<sup>65</sup> unlike the structure defined by the pending claims. At issue before the Examiner is what evidence of record provides motivation for incorporating the moving parts found on the exteriors of the structures in the

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<sup>64</sup> Gokcebay, *et al.*, '777 see column 6, lines 45 through 48.

<sup>65</sup> See Figure 10, of Naveda '127.

secondary references into the interior of the cylinder plug? The primary reference itself, which limits “an electronic access feature ... [to occupancy of] no more space than the mechanical lock itself,”<sup>66</sup> may not be read to provide that motivation.

Turning now to consideration of exemplars of deficiencies of the evidence in the administrative record before the Examiner which were noted earlier in the paper, these deficiencies in the evidence must be considered under the criterion set forth by the Court in *In re Sang-Su Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002):<sup>67</sup>

- By way of an additional example, the Examining Staff has sought to find motivation to incorporate the Thordmark, *et al.* ‘274 and Naveda ‘217 references into the structure of Gokcebay ‘777, despite the fact that Gokcebay ‘777, in teaching his improvements over Appellant’s ‘317 patent, twice teaches against a structure such as that of Naveda ‘217 where the lock’s system “would take up space within the ... lock casing adjacent to the lock.”<sup>68</sup>

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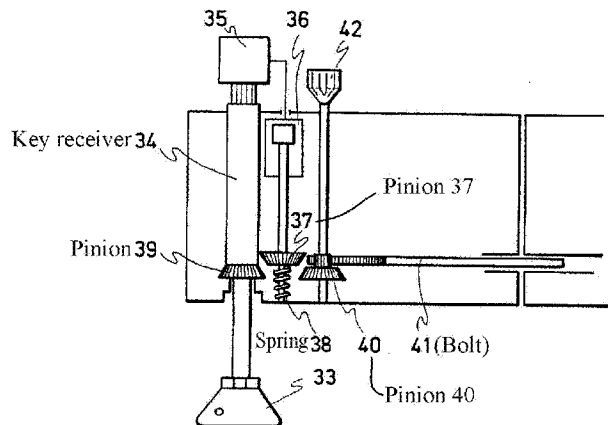
<sup>66</sup> Gokcebay, *et al.*, ‘777 see column 3, lines 1 through 6, together with column 2, lines 53 and 54, column 4, lines 40 through 43, and column 10, lines 10 through 15.

<sup>67</sup> “Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the teaching or suggestion to combine prior art references. ... The need for specificity pervades this authority.” *In re Sang-Su Lee*, 61 U.S.P.Q.2d @1433 (Fed. Cir. 2002).

<sup>68</sup> See Gokcebay, *et al.*, ‘777, at col. 2, lines 39-40 (“the system of the patent [referring to Appellant’s earlier ‘317 patent] requires additional hardware within the lock casing ...”) and col. 2, lines 52-54 (“which avoids the need for electronics, solenoids or other hardware which would *take up space within the ... lock casing adjacent to the lock*”).

Despite this caution by the primary reference against structures such as that taught by Naveda '217, and despite the fact that all of the movable parts of Naveda '217 are in fact, located entirely within the lock's casing,

**Naveda U.S. Patent No. 4416127**  
**Figure 10**



the Examining Staff seems convinced that Naveda '217 teaches the proposition that movable parts such as that taught by Thordmark, *et al.* '274 which are **also wholly external** to the cylinder plug, should be incorporated into the cylinder plug in the manner taught by Appellant's claims. The fact that the sole motivation for such a construction is found in Appellant's claims, is convincing indicia of obviousness *vel non*.

- By way of a second additional example, the Examining Staff has ignored the complete absence from the art of any motivation provided by either Thordmark, *et al.* '274 or Naveda '217, or by Thordmark, *et al.* '274 and Naveda '217 in combination, to incorporate into the cylinder plug of the

Examiner's proposed combination any constituent component other than the solenoid taught by the primary reference, and therefore lacks appellant's cooperation between an electrical operator borne by the cylinder plug and cooperating with a bar.

- By way of a third further example, the Examiner's proposed combination including Gokcebay '777 teaches that the embodiment illustrated in Figures 3, 4 and 5 "allows for secondary locking 'high security' mechanical features,"<sup>69</sup> but is utterly devoid of any teaching or suggestion for structural or functional cooperation between these "secondary locking 'high security' mechanical features" and his "conventional lock cylinder 20", while Thordmark, *et al.* '274 teaches "locks which include two or more **mutually independent** latching or blocking devices, of which one can be activated electrically"<sup>70</sup> and "a lock of the kind ... which has two or more **mutually independent** lock functions",<sup>71</sup> and Neveda '127 teaches but a single magnetic lock. Only Appellant's claims, which when integrated into a conventional locking mechanism, advantageously both (i) recognize the innate deficiencies in locking structure devoted to preserving the mutually independency (as well

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<sup>69</sup> Gokcebay, *et al.*, '777, column 6, lines 54 and 55.

<sup>70</sup> Thordmark, *et al.* '274, column 2, line 66 through column 3, line 1.

<sup>71</sup> Thordmark, *et al.* '274, column 3, line 9.



as the secondariness of Gokcebay ‘777’s “secondary locking”<sup>72</sup> of the lock functions in the prior art and (ii) provide “latching or blocking devices, of which one can be activated electrically”<sup>73</sup> and, unlike the prior art, may be integrated to cooperate in reinforcing the locking function of both locking mechanisms,<sup>74</sup> or alternatively, be selectively controlled to allow the mutual independency of the prior art.

- By way of a fourth example, the embodiment of Figures 3, 4 and 5 of the primary reference in the proposed combination teaches “a bore or recess 50 into which the blocking pin 38 extends in the blocking position.”<sup>75</sup> Incorporation of any component of the secondary references into the primary reference impermissibly destroys the ability of the primary reference to operate in its intended mode of operation with “bore or recess 50 into which

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<sup>72</sup> Gokcebay, *et al.*, ‘777, column 6, line 54.

<sup>73</sup> Thordmark, *et al.* ‘274, column 2, line 66 through column 3, line 1.

<sup>74</sup> It is not customary in U.S. practice to define the advantages that result from a novel structure, such as those advantages provided by a structure such as Appellant’s that flow from positioning an electrical operator to interact with a bar, detent or sidebar; the language of **Claim 64** expressly encompass such a structure and is worded to read: “said sidebar having a first portion that is positioned to be optionally block by another component of said lock functioning independently of said electrical operator to prevent said travel by said sidebar, and a second portion that is positioned to be blocked from said travel by said sidebar to said second position whenever said electrical operator is within said first orientation ... .”

<sup>75</sup> Gokcebay, *et al.*, ‘777, column 6, lines 44 and 46.

the blocking pin 38 extends,”<sup>76</sup> because such an incorporation would inherently block bore 50. This inconsistency is further evidence of non-obviousness.

- By way of a fifth example, incorporation of any component of the secondary references into the embodiment of Figures 3, 4 and 5 of the primary reference in the proposed combination which teaches “a bore or recess 50 into which the blocking pin 38 extends in the blocking position”<sup>77</sup> is a distortion of the teachings of the primary references because Thordmark, *et al.* ‘274 already teaches “a lock cylinder 2 which accommodates a plug 3 ... [and] a side-bar 7 [which] is able to move radially inward in the plug, so as to enable the plug to be rotated”<sup>78</sup>, and preserves that “side bar 7” entirely **mutually independent**<sup>79</sup> from the operation of “latching element 10”, “blocking element 11”, “electric motor 12” and “electromagnet 17”, unlike the structure defined by the pending claims 9 and 10.
- By way of a sixth example, the Examiner’s proposed combination relies entirely upon electrically energy to move external blocking pin 38 of Gokcebay, *et al.*, ‘777, to move external blocking element 11 of Thordmark,

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<sup>76</sup> Gokcebay, *et al.*, ‘777, column 6, lines 44 and 46.

<sup>77</sup> Gokcebay, *et al.*, ‘777, column 6, lines 44 and 46.

<sup>78</sup> Thordmark, *et al.* ‘274, column 4, lines 57-66.

<sup>79</sup> Thordmark, *et al.* ‘274, column 2, line 67, and column 3, line 9.

*et al.*, '274 and to move external pinion 37 of Naveda '127. In contradistinction, Appellant relies is able to use the "torque that is externally applied to said plug and causes rotation of said plug within said shell." There is no evidence of motivation present in the record before the Examiner to modify the primary reference to rely upon externally applied torque to remove "blocking pin 38" from bore 50.

Consequently, there is no basis in the record for sustaining the final rejection of claims 9 and 10.

Moreover, an improvement made in such a very crowded and ancient art is further evidence of non-obviousness. Reversal of this rejection and allowance of claims 9 and 10 is respectfully urged.

Such action is respectfully requested.

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

No fee is incurred by this Substitute Amendment.

Respectfully submitted,

/Robert E Bushnell/  
Robert E. Bushnell,  
Registration No.: 27,774

Customer No. 008439  
2029 "K" Street N.W., Suite 600  
Washington, D.C. 20006-1004  
(202) 408-9040

Folio: P56934  
Date: 10/21/09  
I.D.: REB/kf